

REMARKS/ARGUMENTS

Telephone Interviews

Applicant, John L. Holahan, and his attorneys, Ned W. Randle and J. Philip Polster, thank the Examiner for the courtesy of a telephone interview on April 19, 2010. In the interview, applicant and his attorneys briefly explained some differences between the claimed invention and the cited art and suggested moving the language which the Examiner deemed to be a statement of intended use from the preamble to the body of the claims. No agreement was reached as to allowable claims. The Examiner called shortly after the interview to report that the people within the Office to whom she spoke believed that merely moving a statement of intended use out of the preamble and inserting it later in the claim would not be sufficient to overcome the rejection.

It was agreed that applicant would submit a draft amendment with amendments to the claims for the Examiner's consideration, and that she would call applicant's attorneys to discuss further whether these changes, or others, might avoid the necessity of appealing the case.

Applicant's attorneys, Ned W. Randle and J. Philip Polster again thank the Examiner for taking the time to speak with them by telephone on April 26, 2010. The parties discussed the draft amendment. The Examiner stated that she would not enter the amended claims as proposed after final rejection and suggested that the claims be amended to more clearly point out that the claimed process produces a product suitable

for consumption by an individual with dysphagia. No agreement was reached as to any amendments to the claims. Applicant's attorneys informed the Examiner that they would submit a formal response to the claim rejections.

Amendment of the Specification

Applicant has amended ¶0077 to remove the hyperlink.

Rule 105 Request

Submitted herewith as Exhibit A are copies of product information sheets for SimplyThick®, the packaged thickener concentrate sold by Applicant's assignee. Also submitted with this Amendment is a copy of instructions for using the SimplyThick® thickener concentrate product. These documents were distributed at or around the time of the filing of the instant application. Applicant provided the original information in response to his ongoing duty of candor to the U.S. Patent & Trademark Office.

Election by Original Presentation

Applicant respectfully traverses the Examiner's withdrawal of claims 81 through 89. MPEP 821.03 refers to procedures under 37 CFR 1.145, which provides: "If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed." (Emphasis added).

Elected claims 39-45 are directed to a process for the production of a homogenous single phase thickened beverage using a dispensing machine. Claims 81

through 86 also are directed to a process for the production of a homogenous single phase thickened beverage comprising admixing a thickener concentrate and water in a beverage dispenser. Similarly, claims 87 through 89 provide for a process for producing a thickened liquid food suitable for consumption by a person suffering from dysphagia, comprising dispensing a liquid thickener concentrate from a metering pump into a liquid food to produce a thickened liquid food. Applicant requests that the Examiner rejoin and allow claims 81 through 89 at this time.

Applicant also respectfully traverses the Examiner's withdrawal of claims 57-80, which are directed to a machine adapted to carry out the methods of claims 39-45 and 81-89. Therefore, it is requested that the Examiner rejoin and allow claims 57-80, particularly as amended, when claims 39 - 45 and 81- 89 are deemed allowable.

Applicant appreciates that a final holding that claims 57-89 are withdrawn from consideration establishes uncontestedly that these claims are directed to an invention which is patentably distinct from claims 39-45, but would prefer to prosecute all of the claims in a single application.

Claim Rejections Under 35 U.S.C. §102

The Examiner maintained the rejection of claims 39-45 under 35 U.S.C. 102(b) as anticipated by Wierlo, US Patent No. 3,839,407 ("Wierlo"). Applicant respectfully traverses the rejections. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed.

Cir.1987). Wierlo does not disclose each and every element of the claims, particularly as amended. Contrary to the Examiner's position, the claims do not rely on an intended use. For example, the process claims, particularly as amended, recite an affirmative step of connecting a source of thickener concentrate to a dispensing machine that is capable of dispensing non-thickened beverages to produce a thickened beverage suitable for consumption by a person with dysphagia. Moreover, claim 39 as amended calls for administering the thickened beverage to an individual suffering from dysphagia. Nothing in Wierlo suggests such a process. Wierlo discloses a dispensing freezer having blender apparatus for making multi-flavored milkshakes. Wierlo does not disclose a process that includes connecting a source of thickener concentrate to a dispensing device. Wierlo does not even suggest modification of the mixing machine in this manner. Furthermore, one skilled in the art would recognize that ice cream, frozen custard or the like will melt and change thickness levels, particularly in the mouth, and are not suitable for people with dysphagia. Consequently, Wierlo does not anticipate the claims and they are allowable over the reference.

Applicant notes that contrary to the Examiner's position, the phrase "suitable for consumption by a person suffering from dysphagia" (which has now been placed in the body of the claim) is not a statement of intended use, but is a positive limitation on the thickened beverage produced by the method. It is therefore entitled to be considered in determining whether or not Wierlo's milkshake machine anticipates claim 39. Wierlo clearly does not disclose or suggest a step of administering a thickened beverage to a

person suffering from dysphagia as now called for in claim 39 and withdrawn claims 81 and 87.

New Grounds of Rejections

Claim Rejections Under 35 U.S.C. §112, ¶1

The Examiner rejected claims 39-45 under 35 U.S.C. §112 ¶1 for failing to comply with the written description requirement. Applicant traverses the rejections. Applicant respectfully points out that the Examiner is taking a restrictive view of the written description requirement by expecting the Applicant to parrot language from the specification in the claims. One skilled in the art reading the instant specification, as well as the specification of application Serial No. PCT/US02/24525, which is incorporated by reference into the instant specification at ¶0029, would recognize that the thickener concentrate is an "aqueous liquid thickener" and hence appropriately disclosed in the original specification. Nevertheless, to place the claims in condition for allowance, Applicant has amended claim 39 to call for a "thickener concentrate", which is disclosed numerous times in the instant specification.

The Examiner rejected claims 44 and 45 on the grounds that they contain new matter. Applicant respectfully traverses the rejections. In regards to claim 44, the recited concentration of 1% to 10% is disclosed in ¶0053 of the present specification, as well as at ¶0023 of application Serial No. PCT/US02/24525, the disclosure of which was incorporated by reference, as stated above. Hence, claim 44 does not include new

matter. Claim 45, as amended, has support in the instant disclosure at ¶0029.

Applicant requests withdrawal of the rejections.

Claim Rejections Under 35 U.S.C. §112, ¶2

The Examiner rejected claims 39-45 as being ambiguous. Applicant has amended claim 39, as stated above, which removes the basis for rejection. The claims now are in condition for allowance.

Referring to the rejection of claim 41, Applicant respectfully points out that one skilled in the art would recognize what a sufficient pressure drop is to accomplish the intended function. In any event, Applicant has amended the claim to point out that the exit nozzle is designed to produce sufficient mixing therein so that beverages exit the dispenser at the correct thickness, with a homogenous appearance and are ready to drink, whether the beverage thickness is increased by inclusion of the thickener concentrate or not. Support for this amendment is found at ¶¶0068-69.

Claim Rejections Under 35 U.S.C. §103

The Examiner rejected claims 39-45 as being unpatentable over Applicant's admission in view of Wierlo and further in view of U.S. Patent No. 6,455,090 to Uzuhashi et al ("Uzuhashi"). Applicant traverses the rejections. Applicant respectfully points out that the Examiner has not established *prima facie* obviousness. To establish *prima facie* obviousness all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974), as cited in *The Manual of Patent*

Examining Procedures §2143.03 (2001 ed)(emphasis added). In this case, the *prima facie* case fails because the cited references, either alone or in combination, do not teach or suggest all the claim limitations.

Independent claim 39 calls for a process comprising connecting a source of thickener concentrate to a dispensing machine that is capable of dispensing non-thickened beverages. Neither Applicant's admission, Wierlo nor Uzuhashi, alone or in combination, teach or suggest a process including this step. Applicant's assignee did not sell a product used with a dispensing machine in this manner prior to the filing date of the instant application. Hence, Applicant's admission does not teach or suggest connecting a source of a thickener concentrate to a dispensing machine that is capable of dispensing non-thickened beverages. Wierlo, as discussed above, does not teach or suggest such a process and in fact, teaches away by instructing one skilled in the art to use an unmodified freezer dispenser having a blender apparatus. Uzuhashi does not provide motivation for using a dispensing machine. Uzuhashi discloses only a product and does not teach or suggest such a process using a dispensing machine. Uzuhashi suggests making hand-made foods, thereby teaching away from the use of a dispensing machine. Hence, the combination of references does not teach or suggest the process of independent claim 39, and it is allowable.

Claims 40-45 depend from independent claim 39. *The Manual of Patent Examining Procedure* at § 2143.03 states, "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d Page 18 of 19

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1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988)." Because independent claim 39 is allowable over the art of record, Applicant submits that under the applicable law, claims 40-45 also are allowable.

It is respectfully requested that the case be passed to issue. Should the Examiner have questions or suggestions, she is urged to call applicant's undersigned attorney.

Respectfully submitted,

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